UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Offic
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/957,187	10/24/97	BEER E	514425-3566

IM62/0914

MARILYN MATHES BROGAN
FROMMER LAWRENCE & HAUG LLP
745 FIFTH AVENUE
NEW YORK NY 10151

EXAMINER	
AHMED,S	
ART UNIT	**PAPER NUMBER**
1773	11

DATE MAILED: 09/14/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Advisory Action

Application No.	Applicant(s)
08/957,187	Beer et al.
Examiner	**Group Art Unit**
Sheeba Ahmed	1773

THE PERIOD FOR RESPONSE: [check only a) or b)]

a) ☒ expires 4 months from the mailing date of the final rejection.

b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on _____ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Sep 1, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☒ The proposed amendment(s):

☒ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

☐ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

☐ Applicant's response has overcome the following rejection(s):

_____

☐ Newly proposed or amended claims _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached sheet.

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: *None*

Claims objected to: *None*

Claims rejected: *10-23*

☐ The proposed drawing correction filed on _____ ☐ has ☐ has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ .

☐ Other

1. The Response After Final submitted on September 1, 2000, will be entered upon filing a Notice of Appeal and an Appeal Brief. Applicant's arguments have been fully considered but they are not persuasive.

Applicants traverse the rejection of claims 10-14, 17-19, and 20-23 under 35 U.S.C. 102(b) as being clearly anticipated by Hirose et al. (US 5,532,030), the rejection of claim 15 under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030), and the rejection of claim 16 under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030) in view of Tanaka et al. (U.S. 5,556,920) and submit that the claimed invention possesses a specific set of properties, i.e., water permeation, puncture resistance and thickness, wherein the puncture resistance of the films is obtained by a selected processing of the film, and such properties or procedure to obtain such properties are neither disclosed nor obvious from the Hirose reference. Applicants further allege that if the correct stretching conditions are not chosen properly, the claimed puncture resistance is not achieved. However, as previously pointed out in the Office Action mailed on May 1, 2000, the Examiner has taken the position that these properties are inherent in the multilayer laminate disclosed by Hirose et al. given that the composition and structure of the laminate disclosed by Hirose et al. and the laminate of the claimed invention are identical. Although, the Applicants allege that specific processing is required to obtain the necessary water permeation and puncture resistance, the Applicants have failed to provide any experimental data or other objective evidence to support the assertion that such processing leads to a materially different product than the one disclosed by Hirose. Thus, the

Examiner maintains that the claimed water vapor permeation and puncture resistance are inherent properties of the laminate disclosed by Hirose. Applicants are reminded that once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

Applicants further allege that Hirose only generally mentions that their films can be stretched mono- or biaxially and Hirose relates only to multilayer film whereas the present invention teaches and claims both mon- and multilayer films. Again, as previously pointed out in the Office Action mailed on May 1, 2000, the Examiner wishes to direct the Applicants attention to Columns 34 and 35 which *specifically state* that the multilayer laminate may be subjected to monoaxial or biaxial stretching to produce a sheet or film material suitable for packaging drugs, foods and cigarettes. Furthermore, the Examiner would like to point out that the use of open-claim language in the claims of the instant application, i.e., *comprising*, does not preclude the presence of other layers or elements in the laminate.

It is, again, unclear which rejection the Applicants are addressing when submitting that Hirose fails to provide either the desirability or modification required by Fine.

Hence, the rejections of record are maintained.

2. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594. The Examiner can normally be reached on Monday-Friday from 8am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paul Thibodeau, can be reached at (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.

Sheeba Ahmed
September 13, 2000

Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700